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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,452	11/30/2001	Kristof Van Emelen	JAB-1487	3563

7590

04/04/2003

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EXAMINER

SMALL, ANDREA D SOUZA

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 04/04/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,452

Applicant(s)

VAN EMELEN ET AL.

Examiner

Andrea D Small

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspond nce address --**

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) 4-5 and parts of 1-3, 6-8 and 10-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 4-5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

I. Applicant's Response:

(a) Applicants response filed 3/20/2003 has been received and entered as paper no. 7.

II. Election/Restriction:

(a) In response to the election/restriction requirement, Applicant has elected to prosecute the compound claimed in claim 6 with traverse.

The traversal is on the grounds that unity of invention exists because the compounds of formula I share a common utility. The examiner respectfully disagrees. The technical feature in common with all the groups is the phenyl moiety, this moiety was known in the art prior to the filing of the instant application and thus does not provide a contribution over the art and thus is not a "special technical feature" under the PCT rules 13.1 and 13.2. Therefore, the restriction as outlined is proper and made FINAL.

(b) The election of compound of claim 6 has resulted in the following grouping:

Group VI: Compound of formula (I) wherein:

Alk1 is as claimed;

Alk2 is as claimed;

-Z1-Z2- is a bivalent radical selected from (a-4), (a-7) or (a-9);

R1-R3 are as claimed;

R4 is as claimed, or a direct bond when the bivalent radical -Z1-Z2- is of formula (a-7);

R6 is as claimed;

R5 is selected from (c-1), (c-2) or (c-3);

X is O, S, NR⁹ or CHNO₂;

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Y is O or S;

R8-R10 are as claimed; and

Q is a bivalent radical selected from (d-1), (d-4), (d-5) or (d-6).

(c) Claims that read on the above group are parts of claims 1-3, 6-8 and 10-11. Claims 4-5 and parts of claims 1-3, 6-8 and 10-11 are withdrawn from consideration as being drawn to non-elected inventions. 37 CFR 1.142(b).

III. Rejections:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "intimately" in claim 8 is a relative term which renders the claim indefinite. The term "intimately" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Amending the claim to delete said term is suggested to obviate the above rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-8 and 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by

Wigerinck, et al (US 6,133,277 or related divisional patent US 6,495,547 B1).

Applicant's claims relate to compounds of formula (I) as grouped in group VI identified supra.

Wigerinck, et al teach compounds that fall under the instantly claimed genus. See cols. 23-36, compounds such as 23, 8, 73, 97 and 99, specifically the instant claimed compounds of formula I wherein R1, R2 and R3 is H; Alk1 is alkyl, R6 is phenylmethyl or hydrogen; -Z1-Z2- is -O-CH2-CH2-CH2-; Alk2 is alkyl; R5 is (c-3); Q is (d-1), (d-5) or (d-1) substituted by phenyl; R9 is cyano and R10 is hydrogen.

IV. Objections:

- (a) Claims 1-3, 6-8 and 10-11 are objected to as containing non-elected subject matter.
- (b) Claims 4-5 are objected to as being drawn to non-elected subject matter.

V. Contact Information:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

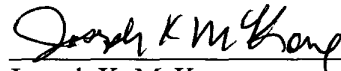
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet

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e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

Andrea D. Small, Esq.
April 2, 2003



Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626
Technology Center 1